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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: **Yuuji SAIKI et al.**

Group Art Unit: **2872**

Application Number: **10/015,991**

Examiner: **Arnel C. Lavarias**

Filed: **December 6, 2001**

Confirmation Number: **3509**

For: **OPTICAL MEMBER AND LIQUID CRYSTAL DISPLAY**

Attorney Docket Number: **020606**

Customer Number: **38834**

SUBMISSION OF APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

July 25, 2007

Sir:

Applicants submit herewith an Appeal Brief in the above-identified U.S. patent application.

Attached please find a check in the amount of \$500.00 to cover the cost for the Appeal Brief. If any additional fees are due in connection with this submission, please charge Deposit Account No. 50-2866.

Respectfully submitted,

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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPEAL BRIEF FOR APPELLANT

Ex parte Yuuji SAIKI et al.

Serial No.: 10/015,991

Filed: December 6, 2001

Appeal No.: Unassigned

Group Art Unit: 2872

Examiner: Arnel C. Lavarias

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Date: July 25, 2007



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No: **Unassigned**

In re the Application of:

Yuuji SAIKI et al.

Confirmation No.: 3509

Serial Number: 10/015,991

Group Art Unit: 2872

Filed: December 6, 2001

Examiner: LAVARIAS, ARNEL C.

For: OPTICAL MEMBER AND LIQUID CRYSTAL DISPLAY

Atty. Docket No.: 020606

Customer No.: 38834

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

July 25, 2007

Applicants appeal the March 27, 2007 Final Rejection of claims 1-4, 9-10, 17-20, and 27-28.

Applicants (now referred to hereinbelow as "appellants") filed a Notice of Appeal on June 27, 2007.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the subject application, which is:

**NITTO DENKO CORPORATION
1-2, Shimohozumi 1-chome
Ibaraki-shi, Osaka 567-8680 JAPAN**

by virtue of an assignment recorded on December 6, 2001 at 27-1772827-1/0112 012617/0378 10015991

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II. RELATED APPEALS AND INTERFERENCES

Appellants know of no other appeals or interference proceedings related to the present appeal.

III. STATUS OF CLAIMS

Claims 5-8, 11-16, 21, and 29-35 have been canceled. Claims 17-20 and 22-26 are pending but have been withdrawn from consideration following an election of species. Claims 1-4, 9-10, and 27-28 stand rejected. No claims are allowed.

The claims whose rejection is appealed are claims 1-4, 9-10, and 27-28. Claim 1 is the only independent claim on appeal.

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention relates to an optical member.

Independent claim 1

In the optical member of the invention, a surface of the optical material is bonded to and covered with a transparent protective film. See, e.g., page 5, lines 16-18, and Fig. 2 (polarizing plate 2 and protective film 1).

The protective film has an outer surface roughness Ra of from 0.03 to 1 μm that does not substantially alter the transparent properties of the protective film. See, e.g., page 5, line 15 (from 0.03 μm) and page 16, lines 20-23 (to 1 μm , transparent properties).

The protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material. See, e.g., page 13, lines 9-12.

Dependent claims

According to claim 2, the protective film is disposed on one surface of the optical material, and a separator is provided on an adhesive layer disposed on the other surface of the optical material so that the separator can be released from the adhesive layer. See, e.g., page 13, lines 13-14, and Fig. 2 (adhesive layer 3 and separator 4).

According to claim 3, the optical material comprises a polarizing plate. See, e.g., page 5, line 18, and Fig. 2 (polarizing plate 2).

According to claim 4, the optical material comprises a polarizing plate, and at least one of a retardation plate and a brightness enhancement plate. See, e.g., page 9, lines 18-22, and Figs. 3-4 (polarizing plate 2, retardation plate 5, brightness enhancement plate 6).

According to claim 9, the optical member is included in a liquid crystal display. See, e.g., page 3, lines 20-21.

According to claims 10, 27, and 28, the protective film has an outer surface roughness Ra of from 0.04 to 1 μm , 0.05 to 1 μm , or 0.06 to 1 μm , respectively. See, e.g., page 16, lines 19-20 (from 0.04, from 0.05, to 1 μm) and page 17, line 24 (from 0.06 μm).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellants appeal the following rejections:

- Rejection of claims 1-3, 9-10, and 27-28 under 35 U.S.C. 103(a) as obvious over WO 00/44841 to Nagahama et al. ("Nagahama") in view of U.S. Patent No.

5,886,819 to Murata et al. (“Murata”),

- Rejection of claim 4 under 35 U.S.C. 103(a) as obvious over WO 00/44841 to Nagahama et al. (“Nagahama”) in view of U.S. Patent No. 5,886,819 to Murata et al. (“Murata”) and further in view of U.S. Patent No. 6,111,699 to Iwata et al. (“Iwata”).

VII. ARGUMENT

Appellants explain herein why the rejections should be reversed.

The following argument applies to claims 1-3, 9-10, and 27-28 as well as claim 4 considered together as a group. Claim 1 is the only independent claim of the group.

The Examiner has failed to establish a prima facie case of obviousness. In particular, the Examiner has not identified a teaching, suggestion or motivation, or other incentive that would be sufficient to lead the person of ordinary skill in the art to combine the cited references as alleged by the Examiner.

In addition, taking into consideration the general knowledge in the art, the Examiner has not identified any knowledge or desire of the person of ordinary skill in the art that would have led to providing the features recited in present claim 1.

Specifically, Murata and Nagahama do not provide any teaching, suggestion or motivation regarding an optical member with a temporary protective film having defined surface roughness Ra as in the presently claimed invention.

A. Murata has a permanent antiglare film, not a removable protective film

The antiglare film of Murata is integral with a polarizer to form part of the optical member which is integrated into the display of Murata. In particular, the antiglare film is not

used temporarily for protection of an optical member during transportation and storage, but is permanently attached to the adjacent optical layer. See, e.g., Murata at col. 7, lines 22-35.

As a result, the antiglare film of Murata is completely different from a protective film as in the presently claimed invention, which comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material, as recited in present claim 1.

B. Murata provides no incentive to add antiglare properties to a temporary protective film such as the surface-protecting film of Nagahama

Contrary to the assertion in the Office Action, it would not have been obvious to use such surface roughness on the removable protective film of Nagahama “to ease or simplify inspection of the underlying attached optical material (e.g. a polarizer element) due to a relatively higher contrast, while reducing or eliminating possible glittering effects during viewing” (Office Action at page 4, end of first paragraph). Specifically, Murata focuses on the antiglare properties of a display, i.e., after the polarizing film is mounted in the finished product. As a result, Murata does not provide any motivation to have an antiglare surface provided on a temporary protective film that will be removed at the time of assembling the polarizing film into a display.

1. Murata seeks to improve the antiglare properties in a display, but not in a film individually, let alone in a temporary protective film

The fact that Murata shows no interest in improving antiglare effect on a temporary protective layer, but focuses exclusively on the antiglare and anti-glitter effect on a mounted display, is immediately apparent from the following statements of Murata:

- Col. 1, lines 43-46: “it is eagerly desired to develop an efficient antiglare means on the display screen which prevents imaging reflection of external light sources such as the sun, fluorescent lamps and the like on the display screens” (emphasis added)
- Col. 2, lines 17-24: “The object of the present invention is accordingly to provide a novel and improved display exhibiting an excellent antiglare effect by preventing imaging reflection of external light sources such as the sun, fluorescent lamps and the like on the imaging screen of the display and capable of giving sharp display images of high resolution without glittering and also to provide an antiglare material suitable for use on a full-color display screen” (emphasis added)
- Col. 7, lines 27-31: The thus formed antiglare material of the invention exhibits an excellent antiglare effect and, when mounted on an image display such as CRTs and LCDs, serves to give a sharp image with high resolution and high contrast without glittering” (emphasis added)
- Col. 7, lines 31-35: “In addition, the polarizing film by the use of such an antiglare material is useful as an image display such as liquid crystal panels and the like because of the good antiglare effect and the excellent image contrast without glittering exhibited thereby” (emphasis added)

These statements, taken individually or together, teach away from providing an antiglare treatment on a removable protective film.

2. Murata evaluates the antiglare properties in a display exclusively

In addition, Murata evaluates an antiglare and antiglittering effect only in the context of a display, so that Murata does not provide any guidance as to the interest and the evaluation of an

antiglare effect or antiglittering effect of a temporary protective layer on the polarizing film before assembly:

- Col. 8, lines 60-63: “Evaluation of the image contrast was undertaken according to the procedure specified in JIS C7072-1988 for the testing method of the contrast ratio (CR) of liquid crystal display panels” (emphasis added)
- Col. 9, lines 10-17: “Glittering of the images due to moiré-image fringes was evaluated in an organoleptic method by the visual inspection undertaken by 100 panel members in which the liquid crystal display 30 was connected to a personal computer... and each of the panel members was requested to visually detect appearance of glittering” (emphasis added)
- Col. 9, lines 21-27: “Antiglare effect was evaluated also in an organoleptic method by the visual inspection undertaken by 100 panel members, in which each of the panel members was requested to find imaging reflection of his or her own face under lighting with a 40 watts fluorescent lamp when he or she faced the liquid crystal display in a black-exhibiting condition perpendicularly at a distance of 50 cm” (emphasis added)

Thus, the focus of the antiglare film of Murata is the antiglare properties in a display, and there is absolutely no indication in Murata whether antiglare properties on a temporary protective film might be of any benefit or, on the contrary, a disturbance.

3. Murata fails to provide any incentive to add antiglare properties in the temporary film of Nagahama

In summary, none of the cited references provides a suggestion or motivation to adapt any optical properties of an antiglare film as in Murata to a temporary protective film. Therefore, the person of ordinary skill in the art would have found no motivation to provide antiglare

properties of the film of Murata to the peel-off surface-protecting film of Nagahama, and any combination of Murata and Nagahama would not have resulted in the presently claimed invention.

The following argument applies to dependent claim 4 considered separately.

With respect to claim 4, it is submitted that Iwata fails to teach or suggest any combination of Murata and Nagahama, and further, Iwata fails to remedy the deficiencies of Murata and Nagahama.

In summary, none of the cited references provides a suggestion or motivation to adapt any optical properties of an antiglare film as in Murata to a temporary protective film. Therefore, the person of ordinary skill in the art would have found no motivation to combine Murata, Nagahama, and Iwata, and any combination of Murata, Nagahama, and Murata would not have resulted in the presently claimed invention.

Summary

For each of the rejected claims, as discussed above, the Examiner has failed to set forth a prima facie case of obviousness, because the person of ordinary skill in the art would not have been led to combine the cited references, and because, in any case, any combination of the cited references by a person of ordinary skill in the art would not have resulted in the features of the presently claimed invention. Accordingly, appellant solicits the reversal of the obviousness rejections of claims 1-4, 9-10, and 27-28 under 35 U.S.C. 103(a).

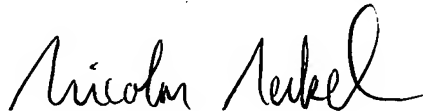
VIII. CONCLUSION

For the above reasons, appellant requests that the Board of Patent Appeals and Interferences reverse the Examiner's rejection of claims 1-4, 9-10, and 27-28.

In the event this paper is not timely filed, appellant petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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Enclosures: Claims appendix
Evidence appendix
Related proceedings appendix

CLAIMS APPENDIX

1. (previously presented): An optical member in which a surface of an optical material is bonded to and covered with a transparent protective film having an outer surface roughness R_a of from 0.03 to 1 μm that does not substantially alter the transparent properties of the protective film, wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material.

2. (previously presented): The optical member according to claim 1, wherein the protective film is disposed on one surface of the optical material, and a separator is provided on an adhesive layer disposed on the other surface of the optical material so that the separator can be released from the adhesive layer.

3. (original): The optical member according to claim 1, wherein the optical material comprises a polarizing plate.

4. (previously presented): The optical member according to claim 1, wherein the optical material comprises a polarizing plate, and at least one of a retardation plate and a brightness enhancement plate.

5-8. (canceled)

9. (original): A liquid crystal display having an optical member according to claim 1.

10. (previously presented): The optical member according to claim 1, wherein the protective film has an outer surface roughness Ra of from 0.04 to 1 μm .

11-16. (canceled)

17. (withdrawn): An optical member according to claim 3, wherein the polarizing plate has a transparent protective layer on one or both faces of a polarizing film.

18. (withdrawn): The optical member according to claim 17, wherein the protective film is disposed on one surface of the optical material, and a separator is provided on the other surface of the optical material via an adhesive layer.

19. (withdrawn): The optical member according to claim 17, wherein the optical material comprises at least one of a retardation plate and a brightness enhancement plate.

20. (withdrawn): The optical member according to claim 17, wherein the protective film has an outer surface roughness Ra of from 0.04 to 1 μm .

21. (canceled)

22. (withdrawn): The optical member according to claim 17, wherein the separator has an outer surface roughness Ra of from 0.05 to 1 μm .

23. (withdrawn): A liquid crystal display having an optical member according to claim 17.

24. (withdrawn): An optical member according to claim 17, wherein a reflecting layer having a fine undulating structure is disposed on the protective layer.

25. (withdrawn): An optical member according to claim 24, wherein the reflecting layer is formed by attaching metal directly onto the surface of the protective layer.

26. (withdrawn): A liquid crystal display having an optical member according to claim 24.

27. (previously presented): An optical member according to claim 1, wherein the protective film has an outer surface roughness Ra of from 0.05 to 1 μm .

28. (previously presented): An optical member according to claim 1, wherein the protective film has an outer surface roughness Ra of from 0.06 to 1 μm .

29-35. (canceled)

EVIDENCE APPENDIX

No evidence under 37 C.F.R. § 41.37(c)(1)(ix) is submitted.

RELATED PROCEEDING APPENDIX

No decisions under 37 C.F.R. § 41.37(c)(1)(x) are rendered.